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SHOOK, HARDY & BACON L.L.P.
(Cerner Corporation)
Intellectual Property Department
2555 GRAND BOULEVARD
KANSAS CITY, MO 64108-2613

EXAMINER
NGUYEN, TRAN N

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 October 2009*.

2a)☒ This action is **FINAL**.　　　2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4,6,7,9-12,15-23 and 26-38* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4,6,7,9-12,15-23 and 26-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

As per the Office Action mailed 06/09/2009:

The rejection of claims 4, 7, 9, 12, 15-22, 27, 30, 34-35 under 35 USC 112, first

paragraph is hereby withdrawn in part in view of Applicant's amendment to claims 4, 7,

12. The remainder of this rejection with respect to claims 27, 30 is hereby maintained in

view of Applicant's failure to adequately traverse this rejection.

The rejection of claims 4, 34, 38 under 35 USC 112, second paragraph is hereby

withdrawn in view of Applicant's amendment to claims 34, 38.

The rejection of claims 1, 4, 6-7, 9-12, 15-23, 26-38 under 35 USC 101 is hereby

withdrawn in part in view of Applicant's amendment to claim 23. The remainder of this

rejection with respect to claims 1, 4, 6-12, 15-22, 34-35, 37-38 is hereby maintained in

view of Applicant's failure to adequately traverse this rejection.

The amendment to the specification filed 10/09/2009 is objected to under 35

U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a)

states that no amendment shall introduce new matter into the disclosure of the

invention. The added material which is not supported by the original disclosure is as

follows:

The newly added disclosure to the specification:

A "System," or computer system, as utilized herein, refers to a configuration that

includes all functional components of a computer and its associated hardware. A basic

microcomputer system includes a console, or a system unit, within one or more disk drives, a

monitor, and a keyboard. Additional hardware, called peripherals, can include such devices as a

printer, a modem, and a mouse.

This newly added disclosure appears to constitute new matter. Applicant did not

point out, nor was Examiner able to find, any support for these newly added limitations

in the specification as originally filed.

In particular, Applicant is adding a controlling definition for "system" that was not

present in the specification as originally filed.

Since Applicant asserts that this disclosure was inherent to the original

disclosure, Applicant is requested to specifically point out how this newly added matter

is inherent.

Applicant is requested to clarify the issues discussed above, to specifically point

out support for the newly added limitations in the originally filed specification and claims

to the extent possible, and to cancel any new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of
making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 27, 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the enablement requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the

invention.

As per claim 27, this claim recites:

the evidentiary support comprises at least clinical

documentation.

The specification discloses (page 7 paragraph 0028):

As used herein, "documentation" may refer broadly

to any hard copy, electronic, optical or other report, data, file or other media or

content, in textual, numeric or other format, which temporarily or permanently

reflects or records information related to the delivery of clinical care.

As provided for by the specification, Examiner interprets "documentation" to

recite any data, including hard copy data.

As recited in claim 27, the claim requires automatically searching for "documentation", including automatically searching for hard copy data.

Accordingly, the specification, while being enabling for automatically searching computerized data, does not reasonably provide enablement for automatically searching hard copy data. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Specifically, one of ordinary skill in the art would not know how to make and use the feature of automatically searching hardcopy data.

As per the set of claim(s): 30, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 27, respectively, and incorporated herein.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 1, 4, 6-12, 15-22, 34-35, 37-38 is/are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 1, this claim recites a "system" comprising a "conditioning engine executable by the computing device".

The "engine" is a recited structural limitation of the claimed system. Insofar as the "computing device" is concerned, this feature has not been recited as part of the claimed system. Therefore, the claim only requires a system comprised of an "engine" capable of being executed by such device.

When read in light of the specification and the level of ordinary skill in the art, "engine" may be broadly interpreted to envelop software *per se*.

The remainder of the claim does not require that the "engine" be stored on any tangible hardware.

Therefore, the claim is directed towards software *per se* structure, and is found to be directed towards nonstatutory subject matter.

All claims dependent thereon, namely claim(s) 4, 6-11, 34, 37-38, fail to remedy these deficiencies, and are therefore rejected for at least the same rationale above, and incorporated herein.

As per claim 12, based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *In re Bilski* et al, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

The claim preamble includes only a nominal recitation of "performed by a computing device". Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. *See Benson*, 409 U.S. at 71-72. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Comiskey*, 499 F.3d at 1380 (citing In re Grams, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

The limitation in the preamble amounts to nominal recitation at best. This recitation is so generic as to encompass any means, such that anyone who performed this method in practice would fall within the scope of these claims. Thus, the recitation of a structure in the preamble is not, in fact, a limitation at all to the scope of the claim, and the claim is directed, in essence, to the method performed by any means. As such,

this recitation alone does not require the claimed method to include a particular machine

such that the method qualifies as a "process" under 35 USC 101.

In particular, the "interrogating", "determining", and "satisfying" steps do not

require any hardware to perform these steps. Insofar as the computing device is

concerned, this structure is only use nominally to store data for use in these steps.

Examiner has determined that these steps are the essential steps of the claim

because these steps yield the solution for the claimed methods.

The remaining steps, although they require a device, are considered to be post-

solution and otherwise nominal recitation of hardware.

As such, the claim fails the "machine" prong of the test.

Since the recited "verified billing item" amounts to mere data transformation, this

claim fails the "transformation" prong of the test.

Because the claim fails both prongs of the test, this claim has been found to be

directed towards nonstatutory subject matter.

All claims dependent thereon, namely claim(s) 15-22, 35, fail to remedy these

deficiencies, and are therefore rejected for at least the same rationale above, and

incorporated herein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim(s) 1, 6, 10-11, 23, 26-29, 32-33, 36-38 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzgerald (20030191667).

As per claim 1, Fitzgerald teaches a computer system (page 3 paragraph 0023) capable of processing (reads on "conditioning") patient claim data (reads on "clinically related billing items") (Abstract), wherein the computer contains thereon a plurality of software applications (reads on "computer software components") (page 3 paragraph 0023), comprising:

(a) software (reads on "a conditioning engine") stored on a computer (Figure 1-2) capable of:

(i) retrieving (reads on "receiving") a patient claim billing record capable of being submitted for pre-processing by trial adjudicator software (reads on "preliminary billing item") (page 3 paragraph 0025) for a patient encounter with a healthcare provider concerning treatment of an injury (reads on "associated with a clinical event") (Figure 4);

(ii) verifying the claim for accuracy (reads on "analyzing") before (reads on "a condition precedent to") the claim is submitted for payment (reads on "transmitting the billing item to a paying party") (page 2 paragraph 0021) by comparing the claim against a plurality of rules (reads on "comparison against a compliance template to determine compliance therewith", wherein the rule is considered to be a "compliance template") (page 2 paragraph 0021);

(b) the computer system is capable of receiving a claim comprising insurance data and billed medical services (reads on "information supporting the billing of services or materials") (Figure 4) (It is noted that this teaching is considered to be "extracted from the clinical event" because the data is descriptive of the patient encounter);

(c) the rules to be applied are selected based on:

(i) the claim, e.g. selecting the applicable rule based on the intended payor of the claim (page 3 paragraph 0026);

(ii) Medicare guidelines (reads on "at least one regulatory guideline") (page 5 paragraph 0036);

(iii) wherein the rules comprise data represent payor requirements and Medicare guidelines (reads on "data fields, which correspond to each of the criteria") that must be satisfied according to Medicare guidelines (page 5 paragraph 0036-0037);

(d) wherein the computer system is capable of:

(i) after the claim is evaluated for accuracy (reads on "upon determining that the billing item complies"), clearing error codes (reads on "dismissing restrictions from elements in the system that prevent the system from configuring the conditioning

engine to transmit the preliminary billing item to the paying party") (page 6 paragraph

0039) and submitting the claim for payment (page 2 paragraph 0021).

Fitzgerald further teaches that the computer is capable of determining that the

insured's last name is missing (reads on "determining that the preliminary billing item is

insufficient to satisfy the at least one regulatory guideline") (Figure 10 label 609).

Fitzgerald further teaches that the computer is capable of determining that the

claim will be denied when there is an error, and automatically fixing the identified error

(page 3 paragraph 0026).

At the time the invention was made, it would have been obvious to one of

ordinary skill in the art to automatically provide a missing insured's last name (reads on

"automatically searching... to verify the existence of computerized data that supports the

preliminary billing item") within the embodiment of Fitzgerald with the motivation of

automatically correcting a claim deficiency.

As per claim 6, Fitzgerald teaches holding a claim (reads on "holds queue") if the

claim data is not in compliance with the rules (reads on "an exception") (page 5

paragraph 0037, Figure 5) if the claim is missing the insured's last name (Figure 10

label 609).

As per claim 10, Fitzgerald teaches storing the rules in a rules warehouse (reads

on a "compliance database") (Figure 2 label 78).

As per claim 11, Fitzgerald teaches that the rules database is capable of being continuously updated (page 2 paragraph 0019).

As per claim 37, Fitzgerald teaches associating a rule with an event, wherein the event specifies that new claim data is available for processing (reads on "extracting the billable items from a clinical data store") (page 5 paragraph 0033).

As per the set of claim(s): 38, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 1, respectively, and incorporated herein.

As per the set of claim(s): 23, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 1, respectively, and incorporated herein.

As per claim 36, Fitzgerald teaches healthcare compliance rules mandated by regulators comprising diagnosis codes, CCI requirements, APGs, DRGs (reads on "affirming data elements") (page 3 paragraph 0026).

As per claim 26, Fitzgerald teaches using the rules to check for missing claim data (Figure 10).

As per claim 27, Fitzgerald teaches using patient data (reads on "a patient chart") (Figure 10).

Insofar as the remainder of the claim is concerned, the applied art need not teach these limitations in view of the optional limitations recited therein.

As per the set of claim(s): 28, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 6, respectively, and incorporated herein.

As per claim 29, Fitzgerald teaches correcting the claim and resubmitting the claim (reads on "while the exception remains in the holds queue") (page 7 paragraph 0047 and throughout).

As per the set of claim(s): 32, 33, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 10, 11, respectively, and incorporated herein.

Claim(s) 4, 7, 9, 12, 15-22, 30-31, 34-35 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzgerald as applied to parent claims 1, 6 above as applicable, and further in view of Barber (4858121).

As per claim 34, Fitzgerald teaches that a claim is missing the insured's last name (Figure 10 label 609). Fitzgerald further teaches returning the claim to the submitter for correction (page 6 paragraph 0039-0040).

Fitzgerald does not teach "affirming data elements that provide a record of services delivered with respect to the clinical event in the form of supporting documentation, which is absent from the preliminary billing item".

According to Fitzgerald, the insured's identification data, e.g. last name, is missing from the claim.

Barber teaches using stored patient identification data to complete claims (column 5 line 50-55).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Barber within the embodiment of Fitzgerald with the motivation of eliminating entry of patient identification data each time the data is needed (Barber; column 5 line 54-55).

As per the set of claim(s): 4, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 34, respectively, and incorporated herein.

In particular, Fitzgerald teaches correcting errors in the claim, including updated the missing patient identification data, and resubmitting the claim for processing (page 6 paragraph 0039-0040).

As per the set of claim(s): 7, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 34, respectively, and incorporated herein.

Examiner interprets retrieving patient identification data from the system, as taught by Barber, to be "automatically retrieving" because the retrieval is computer-implemented.

As per claim 9, Fitzgerald teaches amending the claim if necessary (reads on "while in the holds queue") before submitting the claim for payment (page 6 paragraph 0042). Fitzgerald further teaches that upon determination of an exception condition, the system is capable of scheduling manual intervention or providing an alert (page 4 paragraph 0029).

As per claim 12, Fitzgerald teaches a method (page 7 paragraph 0049) capable of processing (reads on "conditioning") patient claim data (reads on "clinically related billing items") by computer (Abstract), comprising:

(a) retrieving (reads on "receiving") a patient claim billing record capable of being submitted for pre-processing by trial adjudicator software (reads on "preliminary billing item") (page 3 paragraph 0025) for a patient encounter with a healthcare provider concerning treatment of an injury (reads on "associated with a clinical event") (Figure 4), and receiving a claim comprising insurance data and billed medical services (reads on "generated from billable items extracted from the clinical event") (Figure 4);

(b) using the computer, verifying the claim for accuracy before (reads on "a condition precedent to") the claim is submitted for payment (reads on "transmitting the billing item to a paying party") (page 2 paragraph 0021) by comparing the claim against a plurality of rules comprising a Medicare guideline (page 2 paragraph 0021, page 5 paragraph 0036);

(c) using the computer, comparing the claim against a plurality of rules comprising a Medicare guideline (page 2 paragraph 0021, page 5 paragraph 0036), comprising:

(a) selecting the rules, stored on the computer, to be applied based on:

(i) the claim, e.g. selecting the applicable rule based on the intended payor of the claim (page 3 paragraph 0026);

(ii) Medicare guidelines (reads on "at least one regulatory guideline") (page 5 paragraph 0036);

(b) determining that the insured's last name is missing (Figure 10 label 609) (reads on "some of the criteria remains unsatisfied upon comparison").

As discussed with respect to claim 1 above, Fitzgerald teaches automatically updating missing data to provide an error-free claim, and incorporated herein.

Barber also teaches using stored patient identification data to complete claims (column 5 line 50-55).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Barber within the embodiment of

Fitzgerald with the motivation of eliminating entry of patient identification data each time

the data is needed (Barber; column 5 line 54-55).

Fitzgerald further teaches:

(c) after the claim is evaluated for accuracy and errors are corrected,

clearing error codes (page 6 paragraph 0039) and submitting the claim for payment

(page 2 paragraph 0021) (Examiner considers the corrected insured's last name to be

"annotations" because the insured's last name was not part of the original claim) and

sending the claim for adjudication, as discussed above and incorporated herein.

As per claim 35, Fitzgerald teaches healthcare compliance rules mandated by

regulators comprising diagnosis codes, CCI requirements, APGs, DRGs (reads on

"affirming data elements") (page 3 paragraph 0026).

As per claim 15, Fitzgerald teaches using the rules to check for missing claim

data (Figure 10).

As per claim 16, Fitzgerald teaches using patient data (reads on "a patient chart")

(Figure 10).

Insofar as the remainder of the claim is concerned, the applied art need not teach

these limitations in view of the optional limitations recited therein.

As per the set of claim(s): 17, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 6, respectively, and incorporated herein.

As per claim 18, Fitzgerald teaches that the rules are updated from external rule sources (page 4 paragraph 0028). Fitzgerald further teaches applying new rules to claims (page 4 paragraph 0028-0029).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to apply a new set of rules within the embodiment of Fitzgerald and Barber with the motivation of applying the most current version of the rules.

As per the set of claim(s): 19, 20, 21, 22, 30, 31, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 4, 4, 10, 11, 4, 4, respectively, and incorporated herein.

Response to Arguments

Applicant's arguments filed 10/09/2009 have been fully considered but they are not persuasive.

On page 15 Applicant asserts:

In response to the rejection to the amendment to the Specification.

Page 2-3 of the Office Action mailed 06/09/2009 reads as follows:

On 08/13/2008, Applicant filed the following amendment:

Please replace paragraph [0012] of the published application (pgpub.) with the following amended paragraph:

[0012]   Fig. 1 illustrates an architecture in which a system and method for automatic conditioning of clinically related billing may operate, according to an embodiment of the invention. A "system," or computer system, as utilized herein, refers to a configuration that includes all functional components of a computer and its associated hardware. A basic microcomputer system includes a console, or a system unit, within one or more disk drives, a monitor, and a keyboard. Additional hardware, called peripherals, can include such devices as a printer, a modem, and a mouse. As illustrated in that figure, in embodiments a clinical event 102

It appears that Applicant is requesting that the Pre-Grant Publication be amended.

Because the PGPub is not part of the Official file, this amendment does not materially affect the specification in the Official file, and is immaterial to the merits of the instant pending application.

Applicant requested amendment to the Pre-Grant Publication. Since amendments to Pre-Grant Publications do not affect the patentability of the instant pending application, and are not processed by Examiner, this amendment is denied entry due to improper venue.

It is noted that this amendment was not rejected.

On page 15 Applicant asserts:

Further, it is
contended that the amendments to the paragraph [0023] are not new matter and inherent to the
system for automatically conditioning a billing item.

First, since Applicant asserts that the following newly added disclosure is
inherent to the specification as originally filed:

A "system," or computer system, as utilized herein, refers to a configuration that
includes all functional components of a computer and its associated hardware.   A basic
microcomputer system includes a console, or a system unit, within one or more disk drives, a
monitor, and a keyboard.   Additional hardware, called peripherals, can include such devices as a
printer, a modem, and a mouse.

Applicant is requested to specifically point out why this controlling definition for
"system" is inherent in the specification as originally filed. Failing this, Applicant is
requested to provide a controlling definition as supported by the level of ordinary skill in
the art.

Since this controlling definition for "system" was not present in the specification
as originally filed, this amendment is deemed to be new matter.

On page 16-17 Applicant argues:

In response, claim 1 is amended to tie the conditioning engine to another statutory
class. As amended, claim 1 recites a conditioning engine stored on a computing device (e.g.,
computer, machine, or other physical articles). The use of the tangible machine (i.e., computing
device) imposes meaningful limits on a scope of the claim, and imparts patent-eligibility.
Further, the involvement of the tangible machine in the claimed process is not merely

insignificant extra-solution activity, but serves to support the execution of the conditioning engine.

As discussed in the section above, the claim does not require the device to be a structural part of the claimed system. As such, the claim encompasses software *per se* embodiments not tangibly embodied on any hardware.

On page 17 Applicant argues:

Claim 12 is rejected for reciting a process that does not conform with the requirements stated in Bilski.[1] In response, the essential steps of the process are identified and amended to include a "computing device" for implementing those steps. The use of the tangible machine (i.e., computing device) imposes meaningful limits on a scope of the claim, and imparts patent-eligibility. Further, the involvement of the tangible machine in the claimed process is not merely insignificant extra-solution activity, but serves to support the implementation of the process.

As discussed above, the essential steps of claim 12 do not require any statutory machine. The machine is only used peripherally to store data.

On page 20 Applicant argues:

The Fitzgerald reference does not disclose a process for determining compliance of a preliminary billing item that includes comparing the preliminary billing item against a compliance template that has the features of (i) criteria configured based on the preliminary billing item and at least one regulatory guideline, and (ii) data fields, which correspond to each of the criteria, respectively, that record information that satisfies the criteria. Instead, Fitzgerald evaluates claim data—related to provision of healthcare—for accuracy by using rules to validate the claim data for processing payment.² However, these rules are not comparable to the positively claimed structure of the compliance template and they are not customized according to the contents of a particular preliminary billing item.

Applicant does not indicate which claim is being argued.

For purposes of responding to arguments, Examiner assumes *arguendo* that Applicant is arguing claim 1.

Insofar as "criteria configured based on the preliminary billing item and at least one regulatory guideline" and "data fields… that record information that satisfies the criteria" is concerned, Examiner interprets this limitation to recite that data is configured for appropriate use with the "preliminary billing item" and "regulatory guideline".

This is an inherent feature of Fitzgerald because the logic of the claim adjudication process relies on data extracted based on Medicare rules to be applied to the claim.

The determined logic is therefore considered to be "criteria" and "data fields".

For example, Fitzgerald teaches that a claim to be filed with Medicare must contain the insured's last name. This rule/logic is the claimed "criteria".

The determined results of the application of this logic, i.e. whether the claim has

the insured's last name or not, is considered to be "data fields". Indeed, a logical result

of "Yes" or "No" would signify whether the claim contains the last name or not.

Moreover, since Fitzgerald teaches that the claim may be submitted to a plurality

of insurers (e.g. Medicaid) (page 5 paragraph 0036), it is clear that Medicare rules

would not be appropriate for Medicaid claims.

Therefore, Fitzgerald necessarily teaches that each type of claim uses different

logic based on the insurer. This is considered to be "customized according to the

contents of a particular preliminary billing item".

On page 20-21 Applicant further argues:

> Moreover, the rules are not selected based
> on both (a) the preliminary billing item and (b) at least one regulatory guideline, but generally
>
> derived from a repository.

While the rules and logic may be stored in a repository, different rules and logic

are applied to different types of claim payor/insurer, as discussed above and

incorporated herein.

Applicant's arguments with respect to claim 1 on page 21 have been considered

but are moot in view of the new ground(s) of rejection.

On page 22 Applicant argues:

> In particular, Barber does not teach or suggest "automatically searching within a clinical data store to verify the existence of computerized data that supports the preliminary billing item" "upon determining that the preliminary billing item is insufficient to satisfy the at least one regulatory guideline." Rather, the cited portion of Barber simply teaches retrieving information from a library, such as "patient identification, insurance company, and medical treatment."[11] First, this information is not retrieved in response to a determination that the preliminary billing item is insufficient to satisfy regulatory guideline(s). Second, the information sought in Barber is distinct from computerized data that supports the preliminary billing item.

As discussed above, Fitzgerald teaches automatically correcting a claim error, i.e. a missing insured's last name.

Barber was relied on to show the level of ordinary skill in the art. In combination, the applied art suggest that when a missing last name is required, it was known in the art to search patient records to provide this missing data, and using the retrieved data to correct the claim error.

On page 22-23 Applicant argues:

> Further, in the present hospital context, manually performing the process of searching within a clinical data store to verify the existence of computerized data that supports the preliminary billing item is impractical due to the inaccessibility and broad distribution of the computerized data. For instance, the clinician would be required to search databases and other data sources, review logs or records from various health care departments, scan for updated patient account numbers, and the like.[12] Accordingly, utilizing the conditioning engine to

automatically search within a clinical data store to verify the existence of computerized data that supports the preliminary billing item, as claimed, involves extra steps and rapidly searches multiple locations that a human would not be able to perform.

It appears that Applicant is asserting an advantage of the claimed system.

Since the applied art suggest automated data retrieval, the asserted advantage does not distinguish the claim from the applied art.

Conclusion

The new ground(s) of rejection presented in this Office action, if any, was/were necessitated by Applicant's amendment. Accordingly, **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran (Ken) N. Nguyen whose telephone number is 571-

270-1310. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:00

pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Gerald (Jerry) J O'Connor can be reached on 571-272-6787. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

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/T. N./
Examiner, Art Unit 3626
03/02/2010

/Robert Morgan/
Primary Examiner, Art Unit 3626